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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,213	08/05/2003	David Haffner	GLAUKO.011CP1	6863

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EXAMINER

DOWE, KATHERINE MARIE

ART UNIT	PAPER NUMBER
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3734

NOTIFICATION DATE	DELIVERY MODE
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04/04/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No. 10/634,213	Applicant(s) HAFFNER ET AL.	
	Examiner KATHERINE M. DOWE	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7-9,11,27,28,37 and 53-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,7-9,11,27,28,37 and 53-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/2007 and 4/2/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a complete response to the amendment filed 12/21/2007.
2. Claims 5, 7-9, 11, 27, 28, 37, and 53-73 are currently pending.

Drawings

3. The drawings were received on 12/21/2007. These drawings are acceptable.

Allowable Subject Matter

4. The indicated allowability of claims 5-9, 11, 12, 27, 28, 37, and 53-60 is withdrawn in view of the reconsideration of reference(s) to Richter et al. (US 5,968,058) and Mercerau et al. (US 6,450,937). Rejections based on the reconsidered reference(s) follow.

Response to Arguments

5. Applicant's arguments with respect to claims 5, 7-9, 11, 27, 28, 37, and 53-73 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 5, 7-9, 11, 27, 28, 37, and 53-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter et al. (US 5,968,058) in view of Mercerau et al. (US

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6,450,937). Richter et al. disclose the invention substantially as claimed including an instrument and method for delivering implants for treating an ophthalmic condition. The instrument (Fig. 13) comprises a trocar (164) with a cutting edge sufficiently sharp to cut through Schlemm's canal and a biocompatible implant (130) with a cutting edge (158), where the implant is sized to convey aqueous humor from the anterior chamber to fluid outflow path of the eye so as to reduce elevated intraocular pressure (col 2, ln 48-57). The method comprises using the instrument to deliver the implant through a wall of Schlemm's canal, which extends from the sclera into the anterior chamber of the eye (col 5, ln 5-14). The delivery location is determined by imaging collector channel locations (col 3, ln 35-43). However, Richter et al. do not disclose an outer tubular elongate body surrounds the implant and trocar. Mercerau et al. disclose a device for delivering implants to selected body tissue comprising an outer tubular elongate body (12) surrounding a trocar (14) and implant (50). Mercerau et al. teach the outer tubular elongate body comprises a cutting edge (20) for piercing the tissue and forming a bore for delivery of the implant. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Richter et al. to include an outer tubular elongate body with a cutting edge surrounding the trocar and implant. The smooth outer tubular elongate body would provide a straight, even insertion path, thereby causing less trauma to the eye tissue.

Additionally, Richter et al. do not disclose a plurality of implants. Mercerau et al. disclose delivering a plurality of implants (50) into body tissue with a single delivery device such that first and second implants may be delivered to first and second

locations within the body without removing the delivery device from the body. The implants (50) are arranged end to end within the elongate body (12) and are serially dispensed from the elongate body by actuating a pushing member (16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Richter et al. such that the implant comprised a plurality of implants arranged end to end and the device comprised an actuator that serially dispenses the implants within the body. Thus, additional implants may readily be introduced into the eye to better treat severe intraocular pressure build up by providing additional channels to convey aqueous humor from the anterior chamber without requiring additional surgical intervention to deliver each implant individually.

Further regarding claims 28 and 73, Richter et al. and Mercerau et al. disclose the method substantially as claimed as shown above. However, the prior art does not specifically teach first and second implants are delivered to first and second locations that are angularly spaced at least 20 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Mercerau et al. such that when multiple implants were used, first and second implants were spaced at least 20 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215). Furthermore, it would have been obvious to try placing the first and second implants at least 20 degrees apart since it is obvious to choose from a finite number of identified, predictable solutions, with a reasonable expectation of success.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

Katherine Dowe
March 28, 2008

/K. M. D./
Examiner, Art Unit 3734